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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,985	11/19/2001	Byeong H. Jo	D0932-00178	9526

8933 7590 01/29/2003

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EXAMINER

THOMPSON, CAMIE S

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 01/29/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/988,985

Applicant(s)

JO ET AL.

Examiner

Camie S Thompson

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "and/or" in claim 7 is a relative term that renders the claim indefinite. The term "and/or" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to whether or not carbon fibers and aramid fibers are present or just carbon fibers are present in the building material.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

Art Unit: 1774

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Novich et al., U.S. Patent Number 6,042,305.

Novich discloses building support applications and building foundations that use reinforcing fibers that are formed from one or more inorganic materials, organic materials, mixtures and combinations thereof such as glass fibers and thermoplastic polyester fibers as per instant claims 1-5, 7-13 (see column 1, line 56; column 5, line 12 and column 7, line 58-column 9, line 24). The Novich reference also discloses that the reinforcing fibers are present in an amount of preferably 10 to 25 weight percent wherein the fibers are glass fibers as per instant claims 6 and 12 (see column 9, lines 61-65). The process limitations of extrusion, pultrusion, incorporation through a cross-die, dispersion of fibers, compression molding, adding through a helical winding machine, dilution and control of the glass fibers, polymeric fibers and bulk molding compound are not given any patentable weight in a product claim. Claims 2-5, 8-9 and 11-13 are product-by-process claims. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claims are the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. See MPEP 2113.

5. Claims 1-9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Woodside et al., U.S. Patent Number 6,125,905.

Art Unit: 1774

Woodside discloses composite structures used for the buildings wherein the composite is comprised of commingled polymeric and reinforcing fibers as per instant claims 1-5, 8-9 and 11-13 (see column 1, lines 15-60). The Woodside reference also discloses that the polymeric fibers may include polypropylenes and polyesters and the reinforcing fibers may include glass fibers, graphite fibers or aramid fibers as per instant claims 1 and 7 (see column 4, lines 14-68).

Additionally, the Woodside reference also discloses that the ratio of reinforcing fibers to polymer fibers range from about 40/60 to about 60/40 as per instant claims 6 and 12 (see column 4, lines 37-42). The process limitations of extrusion, pultrusion, incorporation through a cross-die, dispersion of fibers, compression molding, adding through a helical winding machine, dilution and control of the glass fibers, polymeric fibers and bulk molding compound are not given any patentable weight in a product claim. Claims 2-5, 8-9 and 11-13 are product-by-process claims. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claims are the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. See MPEP 2113.

6. Claims 1-5, 8-9 and 11-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Fletemier et al., U.S. Patent Number 6,156,682.

Fletemier discloses a composite material used in building construction wherein the polyester fibers are intertwined with reinforcing glass fibers as per instant claims 1-5 and 8-9 and 11-13 (see column 1, lines 5-20 and reference claims 9 and 10). The process limitations of extrusion, pultrusion, incorporation through a cross-die, dispersion of fibers, compression molding, adding

Art Unit: 1774

through a helical winding machine, dilution and control of the glass fibers, polymeric fibers and bulk molding compound are not given any patentable weight in a product claim. Claims 2-5, 8-9 and 11-13 are product-by-process claims. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claims are the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. See MPEP 2113.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 8-9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker et al., U.S. Patent Number 5,547,325 in view of Novich et al., U.S. Patent Number 6,042,305.

Tucker discloses plastic composites used for deck building and fence building wherein the reinforcing fibers include glass, graphite, aramid and polymeric fibers as per instant claims 9 and 10 (see column 7, lines 54-60 and column 13, lines 11-21). The Tucker reference does not disclose that the polymeric fibers and the glass fibers are commingled as per instant claim 1 and

8. Novich discloses building support applications and building foundations that use reinforcing fibers that are formed from one or more inorganic materials, organic materials, mixtures and

Art Unit: 1774

combinations thereof such as glass fibers and thermoplastic polyester fibers as per instant claims 1 and 8 (see column 1, line 56; column 5, line 12 and column 7, line 58-column 9, line 24). The commingled fibers affect the load or stabilization requirements of the building foundations. Therefore, it would have been obvious to one of ordinary skill in the art to commingle the polymeric fibers with the glass fibers in order to provide high load capacity and stabilization for building foundations such as a deck as shown by the Novich reference in column 5, lines 4-13.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (703) 305-4488. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (703) 308-0449. The fax phone numbers for the Group are (703) 872-9310 {before finals} and (703) 872-9311 {after finals}.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

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Cynthia H. Kelly